

PATENT

Application No. 09/267,489  
Attorney Docket No.: 98-092

## R E M A R K S

Claims 1-50 remain in this application.

Claims 51-59 have been cancelled in this paper.

The present invention is primarily concerned with a technique for testing a number of postal mailing lists and selecting one of the postal mailing lists for use based on the test. The test includes sending e-mail messages to list members making up a subset of each of the postal mailing lists. Based on responses to the e-mail messages, one of the postal mailing lists is selected for use.

By contrast, the Druckenmiller reference, upon which the Examiner primarily relies, is concerned with double-qualifying prospective members of an e-mail mailing list. According to the teachings of Druckenmiller, a prospective list member initially registers by filling out a form in a website. Subsequently, an e-mail message is sent to the prospective list member asking the prospective list member to confirm his or her interest in subscribing to the e-mail mailing list.

Applicants will now turn to specific claim language that distinguishes the independent claims from Druckenmiller.

Claim 1.

Claim 1, as now clarifying amended, recites a "method for providing a mailing list test service involving a plurality of postal mailing lists". It is further recited in claim 1 that "each postal mailing list [includes] information about a plurality of list members". The information includes "a postal address for each list member".

Claim 1 further recites the following steps: "(a) sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members", "(b) receiving a plurality of responses, each received response corresponding to an e-mail message sent in (a), each received response being associated with a list member from one of the subsets of list members", and "(c) selecting for use, based on the responses received in (b), one of the plurality of postal mailing lists".

PATENT

Application No. 09/267,469  
Attorney Docket No.: 98-092

In explaining the rejection of claim 1, the Examiner asserted that "[s]electing a mailing list from a plurality of mailing lists is inherent to the process of developing mailing lists...." However, limitation (c) of claim 1 does not merely recite selecting one of a plurality of postal mailing lists. Rather, that limitation specifies that the selection of the one of the plurality of postal mailing lists is based on responses to an e-mail message. Nothing in Druckenmiller or elsewhere in the prior art suggests that a postal mailing list be selected from a plurality of postal mailing lists based on responses to e-mail messages sent to subsets of the postal mailing lists. It is accordingly submitted that claim 1 is patentably distinguished from the Druckenmiller reference.

Remaining independent claims.

The other pending independent claims, which are claims 14, 27 and 39, are all similar to claim 1, in that they recite selection of a postal mailing list based on responses to e-mail messages. Accordingly, claims 14, 27 and 39 are submitted as patentable on the same basis as claim 1.

Dependent Claims.

The other pending claims, which are all dependent claims, are submitted as patentable on the same basis as the respective parent independent claims.

PATENT

Application No. 09/267,489  
Attorney Docket No.: 98-092**Conclusion**

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

Applicants believe no fee is due. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



Dean Alderucci  
Attorney for Applicants  
Registration No. 40,484  
Alderucci@WalkerDigital.com  
Walker Digital LLC  
Five High Ridge Park  
Stamford, CT 06905-1326  
203-461-7337 / voice  
203-461-7300 / fax

February 8, 2002  
Date

PATENT

Application No. 09/267,489  
Attorney Docket No.: 98-092**SPECIFICATION AMENDMENTS  
MARKED UP FORM**

The paragraph beginning at page 7, line 27 has been amended to read as follows.

As shown in Figure 2, data storage device 205 stores a program 202a, mailing list database 202b, recipient database 202c, test database 202d, questions database 202e and transaction database 202f. Program 202a includes instructions for implementing the present invention, examples of which are described in detail [what] with respect to Figures 9-12. For example, program 202a can implement a method for providing a mailing list test service involving a plurality of mailing lists, each mailing list including information about a plurality of list members, to send a computer-based message, such as an e-mail, to each of a subset of list members for each mailing list in the plurality of mailing lists, receive at least one response based on the computer-based message, each received response being associated with a list member from a subset of list members, and selecting for use based on the responses, one of the plurality of mailing lists. The selected mailing list can be sold or leased for a direct-marketing mailing.

The paragraph beginning at page 14, line 2 has been amended to read as follows.

The information presented in Table 650 may be utilized by a business in deciding on the content of the postal mailing to be sent out based on the results of the test e-mails. For example, let's say that Q1 comprised the question "Which layout do you prefer?" and answer choice A1 comprised a first potential layout and answer choice A2 comprised a second potential layout. The results of the test "0099" indicate that the majority of recipients preferred the first potential layout, since A1 had a higher response rate than A2. Alternatively, referring to the same example, the business may choose to utilize the results from each mailing list individually. For example, the business may choose to send a postal mailing to recipients of all three mailing lists A, B, and C, but to include different [layout] layouts for the recipients of the respective mailing lists. In such a scenario, mailing list A recipients will receive the A2 layout, since the majority of mailing list A recipients preferred the layout corresponding to A1. Mailing list B recipients will receive the A2 layout, since the majority of mailing list [A2] B recipients

PATENT

Application No. 09/267,489  
Attorney Docket No.: 98-092

preferred the layout corresponding to A2. Similarly, mailing list C recipients will receive the A1 layout, since the majority of mailing list C recipients preferred the layout associated with A1. In this manner, a business may maximize the potential response rate to a postal mailing.

**The paragraph beginning at page 17, line 4 has been amended to read as follows.**

As an example of this embodiment, assume postal mailing list A contains individuals 1 through 1000, postal mailing list B contains individuals 1001 through 2000, and postal-mailing list C contains individuals 2001 through 3000. The first 100 individuals out of each mailing list are selected as the subsets for the test e-mail (i.e. individuals 1 through [1000] 100, 1001 through [1101] 1100, and 2001 through [2101] 2100). Assume in this example that individuals 10 through 20, 60 through 90, 1080 through 1090, 2006 through 2016, and 2065 through 2080 respond to the e-mail). Based on these responses a new Mailing List D is created that contains individuals 10 through 20, 60 through 90, 1080 through 1090, 2006 through 2016, and 2065 through 2080. The postal mailing can then be sent out to the individuals on postal-mailing list D.

PATENT

Application No. 09/287,489  
Attorney Docket No.: 98-092**CLAIM AMENDMENTS  
MARKED UP FORM**

Claims 1-12, 14-22, 24-35 and 38-50 have been amended to read as follows.

1. (Amended) A method for providing a mailing list test service involving a plurality of postal mailing lists, each postal mailing list including information about a plurality of list members, the information including a postal address for each list member, the method comprising:

(a) sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members;

(b) receiving [at least one response based on an associated] a plurality of responses, each received response corresponding to an e-mail message sent in (a), each received response being associated with a list member from [a subset] one of the subsets of list members;  
and

(c) selecting for use, based on the [at least one response] responses received in (b), one of the plurality of postal mailing lists.

2. (Amended) The method of claim 1, further comprising:

(d) selling the postal mailing list selected in (c).

3. (Amended) The method of claim 1, further comprising:

(d) renting to another the postal mailing list selected in (c).

4. (Amended) The method of claim 1, further comprising:

(d) mailing information via post to list members of the postal mailing list selected in (c).

PATENT

Application No. 09/267,489  
Attorney Docket No.: 98-092

5. (Amended) The method of claim 1, wherein said sending an e-mail message in (a) includes:

(i) sending, for a first postal mailing list in the plurality of postal mailing lists, a first e-mail message to a first member of the subset; and

(ii) sending, for the first postal mailing list in the plurality of postal mailing lists, a second e-mail message to a second member of the subset;

wherein the first e-mail message includes content different from the second e-mail message.

6. (Amended) The method of claim 5, further comprising:

(d) storing the [at least one response] responses received in (b).

7. (Amended) The method of claim 5, wherein at least one of the plurality of postal mailing lists contains a first set of mailing list content, and another of the plurality of postal mailing lists contains a second set of content, and wherein the selecting in (c) includes selecting at least one of the plurality of postal mailing lists based on mailing list content included in the e-mail messages sent in (a).

8. (Amended) The method of claim 1, wherein [the at least one] each response received in (b) includes[, for each received response,] a test identifier and a member identifier, and comprising the further steps of:

(d) retrieving a test record from a test database based on the received test identifier, and

(e) updating the retrieved test record to disclose, based on the received member identifier, that a response was received from a member associated with the member identifier.

9. (Amended) The method of claim 8, wherein [the at least one] each response received in (b) further includes a question identifier and an answer identifier.

PATENT

Application No. 09/267,489  
Attorney Docket No.: 98-092

10. (Amended) The method of claim [7] 9, wherein said selecting one of the plurality of postal mailing lists includes selecting based on the received question identifier and the received answer identifier.

11. (Amended) The method of claim 1, wherein said selecting one of the plurality of postal mailing lists includes:

- (i) determining a response rate of each of the plurality of postal mailing lists; and
- (ii) selecting the postal mailing list that has a response rate higher than the response rates of the other postal mailing lists.

12. (Amended) The method of claim 1, wherein said receiving [at least one response based on an associated c-mail message] responses includes detecting [a response to the e-mail message based on] the use of a uniform resource locator embedded in the e-mail message.

14. (Amended) An apparatus for providing a mailing list test service, comprising:

- (a) a processor;
- (b) a database including a plurality of postal mailing lists, each postal mailing list having information about a plurality of list members, the information including a postal address for each list member;
- (c) a port coupled to said processor; and
- (d) a memory including a database, said memory coupled to said processor, and said memory storing instructions adapted to be executed by said processor, the instructions including:
  - (i) sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members;
  - (ii) receiving [at least one response based on an associated] a plurality of responses, each received response corresponding to an e-mail message sent in [(a)] (i), each



PATENT

Application No. 09/267,489  
Attorney Docket No.: 98-092

received response being associated with a list member from [a subset] one of the subsets of list members; and

(iii) selecting for use, based on the [at least one response] responses received in [(b)] (ii), one of the plurality of postal mailing lists.

15. (Amended) The apparatus of claim 14, wherein said memory stores further instructions adapted to be executed by said processor, said further instructions including:

(iv) selling the postal mailing list selected in (iii).

16. (Amended) The apparatus of claim 14, wherein said memory stores further instructions adapted to be executed by said processor, said further instructions including:

(iv) renting to another the postal mailing list selected in (iii).

17. (Amended) The apparatus of claim 14, wherein said memory stores further instructions adapted to be executed by said processor, said further instructions including:

(iv) mailing information via post to members of the postal mailing list selected in (iii).

18. (Amended) The apparatus of claim 14, wherein the instructions to send an e-mail message include instructions adapted to be executed by a processor to:

send, for a first postal mailing list in the plurality of postal mailing lists, a first e-mail message to a first member of the subset; and

send, for the first postal mailing list in the plurality of postal mailing lists, a second e-mail message to a second member of the subset, wherein the first e-mail message includes content different from the second e-mail message.

19. (Amended) The apparatus of claim 18, said memory storing further instructions adapted to be executed by said processor, the instructions including:

(iv) storing the [at least one response] responses received in (ii).

PATENT

Application No. 09/267,489  
Attorney Docket No.: 98-092

20. (Amended) The apparatus of claim 18, wherein one of the plurality of postal mailing lists contains a first set of mailing list content, and another of the plurality of postal mailing lists contains a second set of mailing list content, and wherein selecting in (iii) includes selecting one of the plurality of postal mailing lists based on mailing list content included in the e-mail messages sent in (i).

21. (Amended) The apparatus of claim 20, wherein selecting in (iii) further includes:

(i) determining a response rate of each of the plurality of postal mailing lists; and

(ii) selecting a postal mailing list from the plurality of postal mailing lists that has a response rate higher than the response rate of the other postal mailing lists.

22. (Amended) The apparatus of claim [13] 14, said database including a mailing list database containing a member identifier, a test database containing a test identifier, a questions database, an answer database, and said memory storing further instructions adapted to be executed on said processor, the further instructions including:

(iv) retrieving a test record from the test database based on a received test identifier; and

(v) marking the retrieved test record to disclose, based on the member identifier, that a response was received from a list member associated with the member identifier.

24. (Amended) The apparatus of claim [13] 14, wherein instructions to select a postal mailing list from the plurality of postal mailing lists include instructions to: determine the response rate of each of the plurality of postal mailing lists; and select the postal mailing list with the highest response rate.

25. (Amended) The apparatus of claim [13] 14, wherein said receiving [at least one response based on an associated e-mail message] responses includes detecting [a response to the e-mail message based on] the use of a URL embedded in the e-mail message.

PATENT

Application No. 09/267,469  
Attorney Docket No.: 98-092

26. (Amended) The apparatus of claim [13] 14, wherein a list member associated with a received response is compensated for the response.

27. (Amended) A medium storing [instruction] instructions adapted to be executed by a processor to provide a mailing list test service for a plurality of postal mailing lists, each postal mailing list including information about a plurality of list members, the information including a postal address for each list member, said instructions comprising:

(a) sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members;

(b) receiving [at least one response based on an associated] a plurality of responses, each received response corresponding to an e-mail message sent in (a), each received response being associated with a list member from [a subset] one of the subsets of list members; and

(c) selecting for use, based on the [at least one response] responses received in (b), one of the plurality of postal mailing lists.

28. (Amended) The medium of claim 27 storing further instructions adapted to be executed by a processor, said further instructions comprising:

(d) selling the postal mailing list selected in (c).

29. (Amended) The medium of claim 27 storing further instructions adapted to be executed by a processor, said further instructions comprising:

(d) renting to another the postal mailing list selected in (c).

30. (Amended) The medium of claim 27 storing further instructions adapted to be executed by a processor, said further instructions comprising:

(d) mailing information via post to members of the postal mailing list selected in (c).

PATENT

Application No. 09/267,469  
Attorney Docket No.: 98-092

31. (Amended) The medium of claim 27, wherein the instructions to send an e-mail message in (a) include further instructions adapted to be executed by a processor to:

- (i) send, for a first postal mailing list in the plurality of postal mailing lists, a first e-mail message to a first member of the subset; and
- (ii) send, for the first postal mailing list in the plurality of postal mailing lists, a second e-mail message to a second member of the subset,

wherein the first e-mail message includes content different from the second e-mail message.

32. (Amended) The medium of claim 31, said medium storing further instructions adapted to be executed by a processor to store the [at least one response] responses received in (b).

33. (Amended) The medium of claim 31, wherein one of the plurality of postal mailing lists contains a first set of mailing list content, and another of the plurality of postal mailing lists contains a second set of mailing list content, and wherein said selecting in (c) includes selecting one of the plurality of postal mailing lists based on mailing list content in the e-mail messages sent in (a).

34. (Amended) The medium of claim 33, wherein said selecting in (c) further includes:

- (i) determining a response rate of each of the plurality of postal mailing lists; and
- (ii) selecting the postal mailing list that has a response rate higher than the response rate of the other postal mailing lists.

PATENT

Application No. 09/267,489  
Attorney Docket No.: 98-092

35. (Amended) The medium of claim 27, wherein [the] each response received in (b) includes[, for each received response,] a test identifier and a member identifier, and wherein the medium includes further instructions adapted to be executed by a processor, said further instructions comprising:

(d) retrieving a test record from a test database based on the received test identifier; and

(e) marking the retrieved test record to disclose, based on the received member identifier, that a response was received from a member associated with the member identifier.

38. (Amended) The medium of claim 27, wherein said instructions to select a postal mailing list include instructions to:

(i) determine the response rate of each of the plurality of postal mailing lists; and

(ii) select the postal mailing list that has the highest response rate.

39. (Amended) A system for providing a mailing list test service involving a plurality of postal mailing lists, each postal mailing list including information about a plurality of list members, the information including a postal address for each list member, the system comprising:

(a) means for sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members;

(b) means for receiving [at least one response based on an associated] a plurality of responses, each received response corresponding to an e-mail message sent in (a), each received response being associated with a list member from [a subset] one of the subsets of list members; and

(c) means for selecting for use, based on the [at least one response] responses received in (b), one of the plurality of postal mailing lists.

PATENT

Application No. 09/267,489  
Attorney Docket No.: 98-092

40. (Amended) The system of claim 39, further comprising:  
(d) means for selling the postal mailing list selected in (c).
41. (Amended) The system of claim 39, further comprising:  
(d) means for renting to another the postal mailing list selected in (c).
42. (Amended) The system of claim 39, further comprising:  
(d) means for mailing information via post to list members of the postal mailing list selected in (c).
43. (Amended) The system of claim 39, wherein said means for sending an e-mail message in (a) includes:  
(i) means for sending, for a first postal mailing list in the plurality of postal mailing lists, a first e-mail message to a first member of the subset; and  
(ii) means for sending, for the first postal mailing list in the plurality of postal mailing lists, a second e-mail message to a second member of the subset, wherein the first e-mail message includes content different from the second e-mail message.
44. (Amended) The system of claim 39, further comprising:  
(d) means for storing the [at least one response] received responses.
45. (Amended) The system of claim 44, wherein one of the plurality of postal mailing lists contains a first set of mailing list content, and another of the plurality of postal mailing lists contains a second set of mailing list content, and wherein said means for selecting includes means for selecting one of the plurality of postal mailing lists based on mailing list content included in sent computer based messages.

PATENT

Application No. 09/267,489  
Attorney Docket No.: 98-092

46. (Amended) The system of claim 45, wherein said means for selecting further includes:

- (i) means for determining a response rate of each of the plurality of postal mailing lists; and
- (ii) means for selecting the postal mailing list that has a response rate higher than the response rate of the other postal mailing lists of the plurality of postal mailing lists.

47. (Amended) The system of claim 39, wherein [the at least one] each response received in (b) includes [, for each received response,] a test identifier and a member identifier, and further comprising:

- (d) means for retrieving a test record from a test database based on the received test identifier; and
- (d) means for marking the retrieved test record to disclose, based on the received member identifier, that a response was received from a member associated with the member identifier.

48. (Amended) The system of claim 47, wherein the {at least one response} responses received in (b) further [includes] include a question identifier and an answer identifier.

49. (Amended) The system of claim 48, wherein said means for selecting one of the plurality of postal mailing lists includes means for selecting based on the received question identifier and the received answer identifier.

50. (Amended) The system of claim 49, wherein said means for selecting one of the plurality of postal mailing lists includes:

- (i) means for determining a response rate of each of the plurality of postal mailing lists; and
- (ii) means for selecting the postal mailing list that has the highest response rate.